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 KEATING DENTAL ARTS, INC.

IN THE UNITED STATES DISTRICT COURT
 FOR THE CENTRAL DISTRICT OF CALIFORNIA
 SOUTHERN DIVISION

JAMES R. GLIDEWELL DENTAL
 CERAMICS, INC. dba GLIDEWELL
 LABORATORIES,

Plaintiff,

v.

KEATING DENTAL ARTS, INC.

Defendant.

AND RELATED COUNTERCLAIMS.

Civil Action No.
 SACV11-01309-DOC(ANx)

**KEATING DENTAL ARTS,
 INC.'S STATEMENT OF
 UNCONTROVERTED
 FACTS AND CONCLUSIONS
 OF LAW IN SUPPORT OF
 ITS MOTION FOR
 SUMMARY JUDGMENT
 CANCELING GLIDEWELL'S
 TRADEMARK
 REGISTRATION**

HEARING:
 Date: December 17, 2012
 Time: 8:30 a.m.
 Crtrm: 9D

Honorable David O. Carter

Pursuant to Rule 56 of the Federal Rules of Civil Procedure and Local Rule 56-1, Defendant Keating Dental Arts, Inc. (“Keating”) submits this Statement of Uncontroverted Facts and Conclusions of Law in support of its Motion for Summary Judgment canceling Plaintiff James R. Glidewell Dental Ceramics, Inc. dba Glidewell Laboratories’ (“Glidewell”) Trademark Registration.

I. MATERIAL FACTS AS TO WHICH THERE IS NO GENUINE DISPUTE

A. Bruxing, Bruxism, and Bruxers

1. The consuming public for the commercial products at issue in this case are dentists and dental laboratories. (Jankowski Decl., Ex. 3, at 7 (Request for Admission No. 6; Mangum Decl., Ex. 50 (Shuck Dep. Tr.), at 138:9 – 141:19).

2. Dentists and other dental professionals refer to the subconscious grinding of teeth as “bruxing” and the associated medical condition as “bruxism.” (Eggleston Decl. ¶ 16; Eggleston Decl., Ex. 65, at 11:20-22, 12:3-4; Mangum Decl., Ex. 50 (Shuck Dep. Tr.), at 33:13-21, 41:19-20, 42:19 – 43:3, 199:21 – 200:2; Jankowski Decl., Ex. 4 (DiTolla Dep. Tr.), at 81:16-17, 184:16 – 185:7).

3. The term “bruxism” is defined in Dorland’s Illustrated Medical Dictionary (32nd Ed. 2012) as “involuntary, nonfunctional, rhythmic, or spasmodic gnashing, grinding, and clenching of teeth. (Eggleston Decl., Ex. 65, at 12:12-14).

4. The term “brux” is defined as “to grind the teeth rhythmically or spasmodically.” (Eggleston Decl., Ex. 65, at 12:14-15).

5. Dentists are taught these terms during dental school, including Glidewell’s in-house dentist, Dr. Michael DiTolla, and Keating’s expert witness with over forty years of experience as a prosthodontist, Dr. David Eggleston.

(Eggleston Decl., Ex. 65, at 12:18-20; Jankowski Decl., Ex. 4 (DiTolla Dep. Tr.), at 184:4 – 185:7).

6. Dentists and other dental professionals refer to dental patients who suffer from bruxism as “bruxers.” (Jankowski Decl., Ex. 4 (DiTolla Dep. Tr.), at 186:20-21; Mangum Decl., Ex. 50 (Shuck Dep. Tr.), at 199:21 – 200:2; Eggleston Decl. ¶ 16; Eggleston Decl., Ex. 65, at 12:3-4, 14:7-8; Jankowski Decl., Ex. 1 at 5 (Interrogatory No. 2); Jankowski Decl., Ex. 3, at 8 (Request for Admission No. 9); Campbell Decl. ¶ 10, 12; Colleran Decl ¶ 7; Jacquinet Decl. ¶ 11; Myers Decl. ¶ 11; Nussear Decl. ¶ 11; Scott Decl. ¶ 11; Stephens Decl. ¶ 10,12; Sweet Decl. ¶ 8).

7. By way of example, peer-reviewed journal articles from the dental field have for decades used “bruxer” as a generic term people suffering from bruxism. (Eggleston Decl., Exs. 68-78).

8. United States patents and patent applications dating back to the 1980’s use the term “bruxer” to identify people suffering from bruxism. (Request for Judicial Notice Ex. A-E).

B. Dental Laboratories and Dental Restorations (“Crowns”)

9. Crowns and bridges are dental restorations used by dentists to treat patients with damaged or missing teeth. (Eggleston Decl., ¶ 9; Jankowski Decl., Ex. 4 (DiTolla Dep. Tr.), at 135:17-21).

10. Dentists order crowns from “dental laboratories” that manufacture the crowns for the dentists based on specifications provided by the dentist. (Eggleston Decl. ¶ 9; Brady Decl. ¶ 2; Campbell Decl. ¶ 2; Colleran Decl. ¶ 2; Jacquinet Decl. ¶ 2; Murphy Decl. ¶ 2; Myers Decl. ¶ 2; Nussear Decl. ¶ 2; Scott Decl. ¶ 2; Stephens Decl. ¶ 2; Sweet Decl. ¶ 2; Tobin Decl. ¶ 2).

11. There are over 2,000 dental laboratories in the U.S. servicing the needs of dentists. (Jankowski Decl., Ex. 5 (Bartolo Dep. Tr.), at 17:7 – 18:2).

12. Plaintiff Glidewell, founded in 1970, is by far the largest dental

1 laboratory in the U.S., employing about 3,300 employees. (Jankowski Decl., Ex.
2 6 (Allred Dep. Tr.), at 51).

3 13. In 2002, Shaun Keating founded Keating Dental Arts. (Mangum
4 Decl., Ex. 54 (Keating Dep. Tr.), at 20:4-11; Keating Decl. ¶ 3).

5 14. Prior to founding his company, from 1984 to 2002, Mr. Keating
6 worked at Glidewell Laboratories. For most of that time, he was the crown and
7 bridge manager and was responsible for approximately 200 employees. (Keating
8 Decl. ¶ 2).

9 15. For decades dental labs primarily manufactured crowns made
10 entirely or partially of porcelain, a material that gives a tooth-like appearance.
11 (Jankowski Decl., Ex. 4 (DiTolla Dep. Tr.), at 34:22 – 42:22; Eggleston Decl. ¶
12 14).

13 16. Dental labs have also developed layered combinations of materials,
14 to create stronger crowns that look tooth-like. (Jankowski Decl., Ex. 4 (DiTolla
15 Dep. Tr.), at 34:22 – 42:22; Eggleston Decl. ¶ 15).

16 17. An example of a layered crown developed years ago is a porcelain-
17 fused-to-metal (“PFM”) crown, which includes a top porcelain layer—visible in
18 the mouth for aesthetics—atop a lower hidden metal layer for strength.
19 (Eggleston Decl. ¶ 15; Jankowski Decl., Ex. 4 (DiTolla Dep. Tr.), at 35:15-22;
20 Mangum Decl., Ex. 50 (Shuck Dep. Tr.), at 235:3-10).

21 18. Bruxers can be a particularly challenging group of patients for
22 dentists because they are notorious for breaking traditional porcelain crowns due
23 to the excessive forces they place on their teeth. (Mangum Decl., Ex. 50 (Shuck
24 Dep. Tr.), at 33:13 – 34:17; Jankowski Decl., Ex. 4 (DiTolla Dep. Tr.), at 80:10
25 – 81:10; Eggleston Decl. ¶ 17).

26 19. Such patients have traditionally been provided with crowns made
27 entirely out of metal, such as gold. (Mangum Decl., Ex. 50 (Shuck Dep. Tr.), at
28 33:13 – 34:17; Jankowski Decl., Ex. 4 (DiTolla Dep. Tr.), at 80:10 – 81:10;

1 Eggleston Decl. ¶ 17).

2 20. Gold is superior to porcelain for bruxers in that it is more durable
3 and capable of withstanding the stresses associated with chewing and teeth
4 grinding. (Eggleston Decl. ¶ 14; Jankowski Decl., Ex. 4 (DiTolla Dep. Tr.), at
5 41:11 – 42:9; Mangum Decl., Ex. 52 (Friebauer Dep. Tr.), at 63:21 – 64:20).

6 21. To patients gold is far inferior to porcelain in that it is not
7 aesthetically pleasing because it does not look like a tooth. (Jankowski Decl.,
8 Ex. 4 (DiTolla Dep. Tr.), at 42:5-16, 52:4-8, 53:4-7, 112:14-19, 170:1-13).

9 22. Because of its poor aesthetics, gold is a “last resort for people with
10 chewing problems.” (Mangum Decl., Ex. 52 (Friebauer Dep. Tr.), at 64:3-12).

11 **C. Glidewell Develops An All-Zirconia Crown As A Replacement For**
12 **Gold Crowns**

13 23. Because many patients are very resistant to receiving gold crowns,
14 dental professionals have sought to develop a crown that is strong like gold but
15 that looks like a natural tooth. Glidewell’s in-house dentist, Dr. DiTolla, for
16 years asked his R&D department “for a cast gold material that’s white like a
17 tooth so patients will accept it.” (Jankowski Decl., Ex. 4 (DiTolla Dep. Tr.) at
18 112:14-21.)

19 24. Glidewell’s Director of R&D repeated Dr. DiTolla’s desire: “His
20 [Dr. DiTolla’s] saying was always, ‘Why can’t we make a full gold crown that
21 is white? Give me a white full gold crown.’” (Mangum Decl., Ex. 52 (Friebauer
22 Depo. Tr.) at 63:13-19.)

23 25. To address Dr. DiTolla’s request, Glidewell spent several years
24 leading up to 2009 developing an all-zirconia crown. (Jankowski Decl., Ex. 4
25 (DiTolla Dep. Tr.) at 61:7-17; Mangum Decl., Ex. 51 (Carden Dep. Tr.) at
26 102:14-22.)

27 26. Zirconia is an extremely strong material that dental labs began
28 using years earlier as a substitute for the metal lower layer in PFM crowns. ”

1 (Mangum Decl., Ex. 52 (Friebauer Depo. Tr.) at 50:11-52:6.)

2 27. Although Zirconia is white, it does not have the appropriate
3 reflective properties to appear tooth-like, so it is not nearly as aesthetic as
4 porcelain. (Jankowski Decl., Ex. 4 (DiTolla Dep. Tr.) at 35:15-36:2; 61:7-13.)

5 28. A big challenge facing Glidewell in creating an all-zirconia crown
6 was making it sufficiently aesthetic, and Glidewell's Director of R&D recalled
7 that its first attempt was a failure: "I remember our first full crown was so ugly,
8 we all thought that it can't be more ugly than gold, but it was more ugly.
9 Unbelievable." (Mangum Decl., Ex. 52 (Friebauer Depo. Tr.) at 62:2-12.)

10 29. Eventually Glidewell's R&D efforts resulted in an all-zirconia
11 crown that it deemed aesthetic enough, and it decided to release the new crown
12 as a new product. (Jankowski Decl., Ex. 4 (DiTolla Dep. Tr.) at 62:5-8.)

13 **D. Glidewell Names Its All-Zirconia Crown "BruxZir"**

14 30. Glidewell's Vice President of Advertising, Jim Shuck, proposed
15 "BruxZir" as the name of the new all-zirconia crown. (Jankowski Decl., Ex. 4
16 (DiTolla Dep. Tr.) at 75:7-16; Mangum Decl., Ex. 50 (Shuck Dep. Tr.) at 15:8-
17 15.)

18 31. As Mr. Shuck explained, the name was chosen to combine
19 **bruxism** and **zirconia**: "That's why we picked the name, because . . . if you see
20 brux or you identify somebody with brux or bruxism, think of zirconium. So we
21 put brux and zir together." (Mangum Decl., Ex. 50 (Shuck Dep. Tr.) at 41:1-13);
22 *see also* (Mangum Decl., Ex. 52 (Friebauer Depo. Tr.) at 72:1-4.)

23 32. Glidewell's in-house dentist, Dr. DiTolla, found the name
24 "memorable" and immediately liked it because it described the functionality of
25 the crown. (Jankowski Decl., Ex. 18; Ex. 4 (DiTolla Dep. Tr.) at 85:15-87:5.)

26 33. Back in June 2009 Dr. DiTolla responded to Mr. Shuck's proposed
27 name as follows:

28 I like BruxZir for a couple of reasons . . .

1 It is catchy, clever and memorable. . . .

2 It also describes it's [sic] main indication as we see it today: an
3 unbreakable crown for your patients who have broken or might break
4 other restorations. When you want gold and the patient wants white,
BruxZir will make both of you happy.

5 No other crown has ever been marketed as the crown for bruxers, . . .

6 . . . The name BruxZir *sells the function of the crown* and not the
7 esthetics. It doesn't try to be something that it's not. *It's a crown for*
8 *bruxers....We have so many "esthetic" restorations, I would prefer to*
emphasize its physical advantages. . . .

9 . . . And, yes, what should I use on a grinder? BruxZir is a great answer.

10 *Id.*

11 34. In his deposition, Dr. DiTolla testified "[I]" I thought it was clever
12 because of the "Zir" for zirconia"; that the dentist was going to know what was
13 in there." (Jankowski Decl., Ex. 4 (DiTolla Dep. Tr.) at 73:8-10.)

14 35. Glidewell's Director of R&D, Mr. Friebauer, also provided a
15 favorable response to the name suggestion of BruxZir by replying by email,
16 "And it all makes sense." (Jankowski Decl., Ex. 18.)

17 36. Mr. Friebauer further explained that "[t]o me, it stands for bruxism
18 and zirconia. It makes sense to me." (Mangum Decl., Ex. 52 (Friebauer Dep.
19 Tr.) at 72:1-4.)

20 37. Glidewell's Sales Manager, Robin Bartolo, also liked the name:
21 "So here you had something that looked like a tooth and yet was strong enough
22 to withstand even patients that would brux at night or during the day. So it was a
23 great name to convey strength." (Jankowski Decl., Ex. 5 (Bartolo Dep. Tr.) at
24 71:19-72:5.)

25 38. Glidewell admits that the mark BRUXZIR was adopted, at least in
26 part, to connote a product that is useful for bruxers and that the product is
27 composed of zirconia. (Jankowski Decl., Ex. 3 at 6.)

E. Glidewell Markets Its All-Zirconia Crown For Use With Bruxers

39. In June 2009, Glidewell began offering for sale the new all-zirconia crown under the name “BruxZir.” (Mangum Decl., Ex. 50 (Shuck Dep. Tr.) at 15:21-16:3; Ex. 51 (Carden Dep. Tr.) at 97:18-21.)

40. Glidewell prominently and widely promoted the new all-zirconia crown to its customers as “ideal” for bruxer patients in the marketing materials it sent to dentists. (Mangum Decl., Ex. 50 (Shuck Dep. Tr.) at 87:18-88:7; 176:19-178:22; Jankowski Decl., Ex. 8; Ex. 10 at 3, 12, 23, 26; Ex. 11 at 1, 3, 5-6; Ex. 12; Ex. 13; Eggleston Decl., Exs. 79-84.)

41. Because the aesthetics of its new all-zirconia crown was poor compared to conventional porcelain crowns, Glidewell further marketed the crown as “More Brawn Than Beauty.” (Jankowski Decl., Ex. 4 (DiTolla Dep. Tr.) at 76:3-17; 122:8-15; 143:21-144:10; Ex. 7 at 1-2, 4, 7-13, 15, 17, 20; Ex. 8 at 1, 4-9; Ex. 9 at 1; Ex. 10 at 1, 12, 23, 26; Ex. 11 at 2, 4; Mangum Decl., Ex. 50 (Shuck Dep. Tr.) at 178:11-22.)

42. Below is an excerpt from a Glidewell marketing document.



(Jankowski Decl., Ex. 10 at 1)

43. Glidewell also promoted the use of its all-zirconia crown for bruxers in technical articles authored by its Vice President of R&D, Mr. Carden. (Jankowski Decl., Exs. 15, 16, 17).

44. By way of example, an article authored by Mr. Carden states that “[p]rimary candidates [for all-zirconia restorations] include bruxers and grinders who do not desire cast gold or metal occlusal PFM restorations.” (Jankowski

Decl., Ex. 16 at 3).

45. Glidewell also promoted the use of its all-zirconia crown as being indicated, or “ideal,” for bruxers on its website. (Jankowski Decl., Ex. 9 at 2; Eggleston Decl., Exs. 80, 81, 82, 83, 84.)

46. The web site further explains that:

When we launched BruxZir Solid Zirconia crowns & bridges in 2009, our intention was to provide a monolithic zirconia restoration ***indicated for bruxers and grinders*** as an esthetic alternative to posterior metal occlusal PFMs and full-cast metal restorations. The result was a material we said was “More Braun than Beauty.”

(Jankowski Decl., Ex. 9 at 2.)

F. The Name “BruxZir” Is Pronounced The Same As “Bruxer”

47. Glidewell’s in-house dentist, Dr. DiTolla, has published many promotional videos available on the internet (through Glidewell’s website or iTunes) that discuss dental techniques relating to the BruxZir product. Glidewell has also produced a DVD of videos relating to the BruxZir product which it mailed to dentists around the country. (Mangum Decl., Ex. 50 (Shuck Dep. Tr.) at 73:16-74:18; 128:9-20.)

48. In those videos, Dr. DiTolla pronounces the name BruxZir and the dental term bruxer identically. (Eggleston Decl., Ex. 65 at 16; Van Hoosear Decl., Ex. V-4.)

49. In their videotaped depositions in this case, Glidewell’s witnesses’ pronounced BruxZir and bruxer identically. (Van Hoosear Decl., Exs. V-1, V-2, V-3.)

50. Starting in early 2011, Glidewell sent a number of cease and desist letters to dental laboratories who uses the word “Bruxer,” or variations thereon, in connection with all-zirconia crowns. (Jankowski Decl., Ex. 6 (Allred Dep. Tr.) at 213:19-264:13 & Exs. 19-34.)

51. In those communications, Glidewell’s General Counsel, Keith

1 Allred, asserted to the third parties that their names were confusingly similar to
2 Glidewell's mark because BruxZir and bruxer sound the same. (Jankowski
3 Decl., Ex. 6 (Allred Dep. Tr.) at 220:5-12; 229:5-8; Ex. 24 at 5; Ex. 25 at 1; Ex.
4 30 at 4; Frattura Decl. ¶ 15.)

5 52. By way of example, on February 14, 2011, Mr. Allred sent the
6 following message to Pittman Dental Lab, who had been advertising a
7 BRUXER All Zirconia Crown: "BruxZir® / BRUXER: *sounds the same*
8 *doesn't it?* And, that is what gives rise to the matter of trademark infringement."
9 (Jankowski Decl., Ex. 25 at 1 (emphasis added)).

10 53. Dentists outside of Glidewell also pronounce BruxZir and bruxer
11 identically. (Eggleston Decl., Ex. 65 at 14; Stephens Decl. ¶ 12; Scott Decl. ¶
12 11; Colleran Decl. ¶ 12; Jacquinot Decl. ¶ 11; Nussear Decl. ¶ 11.)

13 **G. Glidewell Uses "BruxZir" Generically**

14 54. In its promotional materials, Glidewell reinforces the use of
15 "bruxzir" or "bruxer" crown as nomenclature for an all zirconia crown, not as a
16 trademark indicating the source of the product. (Boatright Decl., Ex. A ¶ 51).

17 55. For example, in Glidewell's promotional video, Dr. DiTolla
18 compares a "bruxzir" or "bruxer" crown to a metal occlusal PFM [porcelain
19 fused to metal] crown and a gold cast crown. (Boatright Decl., Ex. A ¶ 27 (First
20 video link); Eggleston Decl., Ex. 65, at 17:3-8).

21 56. These are generic names for types of crowns with which dentists
22 are very familiar. (Eggleston Decl., Ex. 65, at 16:10 – 17:12; Jankowski Decl.,
23 Ex. 4 (DiTolla Dep. Tr.), at 35:15-22; Mangum Decl., Ex. 50 (Shuck Dep. Tr.),
24 at 235:3-10; Mangum Decl., Ex. 50 (Shuck Dep. Tr.), at 33:13 – 34:17;
25 Jankowski Decl., Ex. 4 (DiTolla Dep. Tr.), at 80:10 – 81:10; Eggleston Decl. ¶
26 17).

27 57. Glidewell also uses the word BRUXZIR as a noun and plural noun,
28 which is further evidence of generic use. (Van Hoosear Decl., Ex. V-4;

(Compendium Clips) (“this Bruxzir is 100% zirconia” and “one question I get about Bruxzirs is . . .”) and “We do 15,000, say, BruxZirs a week.”); Van Hoosear Decl., Ex. V-1 (Shuck Dep. Video Clips); Van Hoosear Decl., Ex. V-2 (DiTolla Dep. Video Clips); Van Hoosear Decl., Ex. V-3 (Carden Dep. Video Clips); Jankowski Decl., Ex. 6 (Allred Dep. Tr.), at 195:22 – 196:1).

58. Dr. DiTolla, states in Glidewell’s promotional videos that one could even get “a couple of BruxZirs put in.” (Boatright Decl., Ex. A ¶ 51).

59. Dr. DiTolla gives continuing education lectures to dentists around the country. His most requested lecture is on monolithic restorations, and during his lecture he uses the terms “BruxZir crown” and “full-contour zirconia” interchangeably for educational purposes. He states, “I want to drive it into them and make sure they walk away knowing that it’s a solid zirconia crown.” (Jankowski Decl., Ex. 4 (DiTolla Dep. Tr.), at 224:13 – 226:6).

H. The Widespread Use of “Brux” and “Zir” In The Dental Industry

60. In addition to Glidewell and Keating, many other companies have been using “Brux” to refer to dental products for use with bruxers and “Z” or “Zir” to refer to dental products associated with zirconia. Examples include:

- Arthtek Bruxing Splint (Eggleston Decl., Ex. 121)
- GPS BruxArt (Eggleston Decl., Ex. 114)
- BruxChecker (Eggleston Decl., Ex. 122)
- Brux-eze (Eggleston Decl., Ex. 124)
- BruxCare (Eggleston Decl., Ex. 125)
- Bruxguard (Eggleston Decl., Ex. 126)
- Dr. Brux (Eggleston Decl., Ex. 123)
- ZirCAD (zirconia blocks) (Eggleston Decl., Ex. 129)
- ZirColor (coloring product for zirconia) (Eggleston Decl., Ex. 135)
- ZirPress (for ceramic ingots) (Eggleston Decl., Ex. 130)
- ZirLiner (zirconia bonding material) (Eggleston Decl., Ex. 131)

- Zir-Cut (zirconia polisher) (Eggleston Decl., Ex. 127)
- ZirBlock (dental products) (Eggleston Decl., Ex. 128)
- Zirprime (pre-sintered zirconia) (Eggleston Decl., Ex. 132)
- Zir.Care (multipurpose stone) (Eggleston Decl., Ex. 133)
- ZiReal (Zr dental posts) (Eggleston Decl., Ex. 134)

I. All-Zirconia Crowns Offered By Other Dental Laboratories

61. In addition to Glidewell and Keating, many other dental laboratories have been offering all-zirconia crowns under a variety of names, including names with “Brux,” “Zir,” or variations thereon. Examples include:

- *Advanced Dental Lab — BruxZir (Jankowski Ex. 31)
- *Assured Dental Lab — Z-Brux (Jankowski Ex. 28)
- *Authentic Dental Lab — Brux (Jankowski Ex. 27)
- *Barth Dental Lab — Z-Brux (Jankowski Exs. 34 & 37)
- Burbank Dental — Zir-Max (Eggleston Decl., Ex. 99)
- California Dental Arts — ZirFit (Eggleston Decl., Ex. 103)
- CDLLab – ZerisBRUX (Eggleston Decl., Ex. 109)
- *China Dental Outsourcing — “Bruxer All Zirconia” (Jankowski Ex. 29)
- *China Dental Outsourcing — All Zirconia for Bruxers (Jankowski Ex. 39)
- Continental Dental — Full Zirconia for Bruxing Patients (Eggleston Decl., Ex. 112)
- Cosmetic Dentistry of SA — Bruxer Crown (Eggleston Decl., Ex. 119)
- Dani Dental — Full Zirconia (Bruxer) (Jankowski Ex. 43)
- Diadem Precision Technology — Diazir (Eggleston Decl., Ex. 101)
- Drake Dental — Zir-Cast (Eggleston Decl., Ex. 96)
- Expertec — Full-Z (Eggleston Decl., Ex. 93)

- 1 • *Fusion Dental Lab — “Full Solid Bruxer Zirconia” (Jankowski Ex.
- 2 24)
- 3 • GPS Dental Lab — GPS BruxArt (Eggleston Decl., Ex. 114)
- 4 • Infinity Dental Lab — Bruxer Crowns (Eggleston Decl., Ex. 108)
- 5 • Kastle Mills — ZirCrown (Eggleston Decl., Ex. 100)
- 6 • Mascola Esthetics — Xtreme Bruxer (Eggleston Decl., Ex. 110)
- 7 • *Old Dominion Milling Corp. — Bruxzer (Jankowski Ex. 32)
- 8 • *Pittman Dental — ZirCAM All-Zirconia (Eggleston Decl., Ex. 106)
- 9 • *Pittman Dental — Bruxer Crown (Eggleston Decl., Ex. 120)
- 10 • *R-dent Dental Laboratory — R-Brux (Eggleston Decl., Ex. 117)
- 11 • *Showcase Dental Lab — Zir-Bruxer (Jankowski Exs. 30 & 38)
- 12 • Somer Dental Labs — Full Contour Zir (Eggleston Decl., Ex. 104)
- 13 • Summers Dental Lab — BruxThetix (Eggleston Decl., Ex. 113)
- 14 • Sun Dental Labs — Suntech Full Zirconia (Eggleston Decl., Ex. 94)
- 15 • Technics Dental Lab — Tech/ZIR FC (Eggleston Decl., Ex. 105)
- 16 • Trachsel Dental — All Zirconia Bruxer (Jankowski Ex. 42)
- 17 • York Dental Lab — Bruxer (Eggleston Decl., Ex. 111)
- 18 • Zahn Dental — Zirlux (Eggleston Decl., Ex. 102)

19 62. These dental laboratories prominently promote their all-zirconia
20 crowns for use by bruxers. Examples include:

- 21 • Barth Dental Labs — “ideal for bruxers.” (Jankowski Ex. 37)
- 22 • California Dental Arts — “Perfect for bruxers” (Eggleston Decl., Ex.
- 23 103)
- 24 • China Dental Outsourcing — “primarily for bruxers and heavy biters”
- 25 (Jankowski Ex. 39)
- 26 • Drake Dental — “Recommended for Bruxers and Grinders”
- 27 (Eggleston Decl., Ex. 96)
- 28 • Expertec — “ideal for patients who brux” (Eggleston Decl., Ex. 93)

- 1 • Infinity Dental Lab — “Bruxer Crowns” (Eggleston Decl., Ex. 108)
- 2 • Sun Dental Labs — for “bruxers and grinders” (Eggleston Decl., Ex.
- 3 94)
- 4 • York Dental Lab — “ideal restoration for bruxers” (Eggleston Decl.,
- 5 Ex. 111)

6 63. As noted above, Glidewell has sought to stop all other dental labs
7 from using the word “Bruxer,” or variations thereof, in the name of their all-
8 zirconia crowns. The dental labs in the list above marked with an asterisk
9 received cease-and-desist letters from Glidewell. (Jankowski Decl., Ex. 6
10 (Allred Dep. Tr.) at 213:19-264:13 & Exs. 24-34).

11 **J. Glidewell Labs Do Not Identify Glidewell As Source**

12 64. Glidewell makes zirconia “blanks” (the raw material from which
13 zirconia crowns may be made) that it sells to about 180 “authorized” dental
14 laboratories around the U.S. for use by those laboratories in making their own
15 all-zirconia crowns. (Mangum Decl., Ex. 51 (Carden Dep. Tr.), at 141: 17 –
16 142:5, 201:16 – 202:5, 208:4 – 209:2; Jankowski Decl., Ex. 4 (DiTolla Dep.
17 Tr.), at 98:3-13, 129:9-14).

18 65. The “authorized” laboratories make and sell crowns using the
19 BruxZir name, just like Glidewell does. (Eggleston Decl., Ex 67 at 4:22 – 5:15;
20 Eggleston Decl., Ex. 136).

21 66. Most of the “authorized” laboratories have web sites promoting
22 their “BruxZir” crowns, often with the same language used in Glidewell’s
23 marketing materials. (Eggleston Decl., Ex 67 at 4:22 – 5:15; Eggleston Decl.,
24 Ex. 136).

25 67. The many labs that Glidewell has authorized to make and sell
26 crowns made from its BruxZir material (including at least one who previously
27 received cease and desist letters) do not identify Glidewell as the source.
28 (Eggleston Decl., Ex. 136; Eggleston Decl., Ex. 137).

1 68. Glidewell does not monitor the use of the BruxZir mark by its
2 authorized labs, and it does not require those labs to identify Glidewell as an
3 affiliated entity. (Jankowski Decl., Ex. 6 (Allred Dep. Tr.), at 141:10 – 143:8;
4 Jankowski Decl., Ex. 5 (Bartolo Dep. Tr.), at 178:11-22, 135:11 – 134:19).

5 69. This practice reinforces the understanding among dentists that
6 “BruxZir” is a product available from multiple sources, not an indicator of a
7 single source or producer. (Eggleston Decl., Ex. 67, at 3:7 – 5:15).

8 **K. Dentists Use The Term “BruxZir” Generically**

9 70. In May 2011, Keating Dental Arts began offering for sale an all-
10 zirconia crown called the “KDZ Bruxer.” (Mangum Decl., Ex. 53 (Brandon
11 Dep. Tr.) at 63:8-15; Keating Decl. Ex. F.)

12 71. Over the following year Keating fulfilled over 5,000 prescription
13 forms by supplying its dentist customers with the KDZ Bruxer product.
14 (Mangum Decl., Ex. 53 (Brandon Dep. Tr.) at 60:13-17; 66:3-7; 68:6-8.)

15 72. Over that span, dentists (or their assistants) wrote the word
16 “bruxzir,” “bruxzer,” or variations thereof, on about seventy-five of the
17 prescription forms requesting all-zirconia crowns. (Mangum Decl., Ex. 53
18 (Brandon Dep. Tr.) at 56:23-57:6.)

19 73. This corresponds to approximately 1.5% of the prescription forms
20 over that time period. (Mangum Decl., Ex. 53 (Brandon Dep. Tr.) at 68:9-11.)

21 74. When receiving prescription forms with such misspellings, it was
22 Keating’s policy to call the dentist and confirm that they wanted Keating’s all-
23 zirconia crown, and not the crown from any other laboratory. (Mangum Decl.,
24 Ex. 53 (Brandon Dep. Tr.) at 68:12-18.)

25 75. In these instances, the dentist always confirmed that they wanted
26 Keating’s KDZ Bruxer all-zirconia crown. (Mangum Decl., Exs. 59, 61, 62.)

27 76. Many dentists in the industry refer to all-zirconia crowns as a
28 “BruxZir,” “bruxzir,” or variations thereon. (Eggleston Decl., Ex. 65 at 16-18;

1 Ex. 66 at 3-7.)

2 77. Dentists who submitted prescription forms to Keating with such
3 spellings wrote that word as a generic reference to an all-zirconia crown, not to
4 identify Glidewell Laboratories as a source. Keating is submitting thirteen
5 declarations from dentists who submitted prescription forms to Keating with
6 “BruxZir” written on them to explain this point. (Belton Decl., ¶¶ 9-11; Brady
7 Decl., ¶¶ 9-11; Campbell Decl., ¶¶ 10-12; Colleran Decl. ¶¶ 10-12; Jacquinet
8 Decl., ¶¶ 9-10; Murphy Decl., ¶¶ 9-11; Myers Decl., ¶¶ 9-10; Nussear Decl., ¶¶
9 9-11; Richardson Decl., ¶ 10-12; Scott Decl., ¶¶ 9-11; Stephens Decl., ¶¶ 10-12;
10 Sweet Decl., ¶¶ 8-10; Tobin Decl., ¶¶ 9-11.)

11 78. Showcase Dental Laboratory, a dental lab unaffiliated with
12 Glidewell or Keating, has also received prescription forms from dentists
13 ordering all-zirconia crowns that generically describe an all-zirconia crown as a
14 “BruxZir,” “bruxzir,” or variation, thereof. (Frattura Decl., ¶¶ 7-9, 18; Ex. A.)

15 **L. Keating Adopted Its KDZ Bruxer Mark In Good Faith**

16 79. Based on the perceived demand of its dentist customers for all-
17 zirconia crowns, Keating decided to formally add an all-zirconia crown to its
18 KDZ line of products (which had been introduced in 2006). (Mangum Decl., Ex.
19 54 (Keating Dep. Tr.), at. 43:15 – 45:12).

20 80. Because the new all-zirconia crown was specifically designed to
21 replace gold crowns for bruxer patients, Mr. Keating wanted to call the new
22 crown the “KDZ Bruxer.” (Mangum Decl., Ex. 54 (Keating Dep. Tr.), at. 43:15
23 – 45:12).

24 81. On March 31, 2011 Keating sent a letter to all of its
25 dentist/customers referencing the increase in the cost of gold and offering a
26 KDZ family of products consisting of:

- 27 • KDZ Bruxer (“Solid Zirconia for bruxer & grinder patients”)
- 28 • KDZ Ultra (a rebranding of the existing KDZ Zirconia product)

1 (Keating Decl. ¶ 12) and

2 • KDZ Max (a ceramic pressed onto a zirconia base)

3 (Keating Decl. Ex. F).

4 82. Mr. Keating sought the advice of counsel, Mr. Gourde, who
5 performed a trademark search, to ensure his use of the name would not cause
6 problems. (Mangum Decl., Ex. 54 (Keating Dep. Tr.), at 43:15 – 45:12; Keating
7 Decl. ¶ 10).

8 **M. Glidewell Has Presented No Credible Evidence Of Actual Confusion**

9 83. In its responses to Keating’s interrogatories, Glidewell alleged
10 details for two instances of alleged actual confusion.

11 • In April 2012, a Glidewell employee named Nicole Fallon offered a
12 \$20 coupon to Dr. Jade Le’s dental office in Florida to try a BruxZir
13 restoration. An employee in Dr. Le’s office asked if she could apply
14 the coupon to a previous purchase the office had made of Keating’s
15 KDZ Bruxer. (Jankowski Decl., Ex. 1 (Interrogatory Nos. 7 & 8).

16 • In May 2011, Dr. Thomas Nussear’s dental office placed an order with
17 Keating for a KDZ Bruxer crown and wrote “BruxZir” on the
18 prescription form. (Jankowski Decl., Ex. 1 (Interrogatory Nos. 7 & 8).

19 84. In response to Keating’s follow up interrogatory, Glidewell
20 explained that Ms. Fallon made a telephone call to Dr. Le’s office and offered a
21 discount on BruxZir crowns. (Jankowski Decl., Ex. 2 (Interrogatory No. 23);
22 Jankowski Decl., Ex. 1 (Interrogatory Nos. 7 & 8)).

23 85. Glidewell employees, and dental professionals generally,
24 pronounce “BruxZir” and “Bruxer” identically. (Van Hoosear Decl., Exs. V-1,
25 V-2, V-3; Eggleston Decl., Ex. 67 at 1:26 – 2:3; Eggleston Decl., Ex. 66 at 3:10
26 – 4:5; Eggleston Decl., Ex. 65 at 12:5, 14:9-22).

27 86. In response to Keating’s follow up interrogatory, Glidewell pointed
28 again to Dr. Nussear’s “Rx Order Form” (prescription form). (Jankowski Decl.,

1 Ex. 2 (Interrogatory No. 22); Jankowski Decl., Ex. 1 (Interrogatory Nos. 7 & 8))
2 87. Dr. Nussear wrote “BruxZir” on his prescription form as a generic
3 reference to an all-zirconia crown. (Nussear Decl. ¶¶ 9 & 11). Furthermore, Dr.
4 Nussear neither intended to order a crown from Glidewell, nor was he confused
5 as to any affiliation between Keating and Glidewell. (Nussear Decl. ¶ 10).

6 **N. The Trademark Office Did Not Fully Examine Glidewell’s**
7 **Trademark Application For “BruxZir”**

8 88. Glidewell filed to federally register a trademark in the mark
9 BRUXZIR for use with dental restorations on June 17, 2009. (Boatright Decl.,
10 Ex. B).

11 89. On January 19, 2010, Glidewell’s issued as Trademark Registration
12 No. 3,739,663. (Boatright Decl., Ex. B).

13 90. During the examination process, the Trademark Examiner did not
14 conduct an Internet search and made no inquiry as to whether BRUXZIR had
15 any meaning in the dental industry. (Boatright¹ Decl., Ex. B; Boatright Decl.,
16 Ex. A ¶¶ 39, 34, 42, 44-47).

17 91. The Examiner should have performed a search of the Internet for
18 “crowns designed for bruxers.” (Boatright Decl., Ex. A ¶ 42).

19 92. Had the Examiner learned that Glidewell pronounces BRUXZIR
20 the same as “bruxer,” and promotes the same pronunciation in its marketing
21 materials for the BruxZir product, the mark would have been denied registration
22 as either generic or merely descriptive. (Boatright Decl., Ex. A ¶ 38).

23 93. Trademark Examiners are obligated to follow the Trademark
24 Manual of Examining Procedure (TMEP) when examining applications.
25 (Boatright Decl., Ex. A ¶ 44).

26
27 ¹ Plaintiff’s expert, Lori Boatright submitted an expert report in rebuttal to
28 the expert report of Glidewell’s legal expert, David Franklyn. Boatright Decl.,
Ex.A.

1 reasonable jury could reach a contrary conclusion. *Id.* at 248.

2 **B. The Presumption of Validity of Glidewell's Trademark Registration**
3 **Can Be Rebutted By A Preponderance of Evidence**

4 7. Because BRUXZIR is a registered trademark, "a presumption of
5 validity places the burden of proving genericness upon" Keating.
6 *Advertise.com, Inc. v. AOL Advertising, Inc.*, 616 F.2d 974, 977 (9th Cir. 2010)
7 (citing *Filipino Yellow Pages, Inc. v. Asian Journal Publ'ns Inc.*, 198 F.3d 1143,
8 1146 (9th Cir. 1999). 15 U.S.C. § 1057(b).

9 8. Keating may rebut this presumption by a preponderance of the
10 evidence showing the mark is generic or lacks secondary meaning. *Yellow Cab*
11 *Co. of Sacramento v. Yellow Cab of Elk Grove, Inc.*, 419 F.3d 925, 928 (9th Cir.
12 2005) ("The defendant may, of course, overcome the presumption 'by a
13 showing by a preponderance of the evidence that the term was or has become
14 generic.'"); *Surgicenters of Am., Inc. v. Med. Dental Surgeries, Co.*, 601 F.2d
15 1011, 1014 (9th Cir. 1979).

16 9. "The crucial date for the determination of genericness is the date on
17 which the alleged infringer entered the market with the disputed mark or term.
18 *Yellow Cab*, 419 F.3d at 928.

19 **C. "BruxZir" is Generic and/or Commonly Descriptive and is Not**
20 **Entitled to Trademark Protection**

21 11. 15 U.S.C. § 1127 defines a trademark "as including 'any word,
22 name, symbol, or device or combination thereof' used by any person 'to identify
23 and distinguish his or her goods, including a unique product, from those
24 manufactured or sold by others and to indicate the source of the goods, even if
25 that source is unknown.'" *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763,
26 768 (1992) (quoting 15 U.S.C. § 1127).

27 12. In determining whether a mark is entitled to trademark protection,
28 the courts recognize four categories of terms: 1) generic; 2) descriptive; 3)

1 suggestive; and 4) arbitrary or fanciful. *Rudolph Int'l, Inc. v. Realys, Inc.*, 482
2 F.3d 1195, 1196-98 (9th Cir. 2007) (affirming summary judgment of
3 genericness), citing *Filipino Yellow Pages, Inc. v. Asian Journal Publ'ns, Inc.*,
4 198 F.3d 1143, 1146 (9th Cir. 1999) (citing *Surgicenters*, 601 F.2d at 1014.

5 13. A generic term, also known as a common descriptive term, refers to
6 the type or species of the product at issue. Generic terms cannot be protected
7 trademarks. Descriptive terms “generally do not enjoy trademark protection” but
8 may be protected if they acquire ‘secondary meaning’ in the minds of
9 consumers, i.e., [they] become distinctive of the trademark applicant’s goods in
10 commerce. *Rudolph*, at 1197-98 (internal citations omitted). See also
11 *Advertise.com* 616 F.3d at 977 (finding registered mark generic).

12 14. “To allow trademark protection for generic terms . . . even when
13 [they] have become identified with a first user, would grant the owner of the
14 mark a monopoly, since a competitor could not describe his goods as what they
15 are.” *Surgicenters*, 601 F.2d at 107.

16 1. **Glidewell’s “BruxZir” Mark Identifies The Product, Not The**
17 **Producer**

18 15. The determination of whether a mark is generic depends on how
19 the consuming public understands the meaning of the term. *Yellow Cab*, 419
20 F.3d at 929 (“To determine whether a term has become generic, we look to
21 whether consumers understand the word to refer only to a particular producer’s
22 goods or whether the consumer understands the word to refer to the goods
23 themselves.” (quoting *KP Permanent Make-up, Inc. v. Lasting Impression I,*
24 *Inc.*, 408 F.3d 596, 604 (9th Cir. 2005)); see also *Rudolph*, 482 F.3d at 1198;
25 *Filipino Yellow Pages, Inc. v. Asian Journal Publ'ns, Inc.*, 198 F.3d 1143, 1148
26 (9th Cir. 1999) (“[T]he ‘ultimate test’ of genericness [sic] is ‘how a term is
27 understood by the consuming public.’” (quoting *Surgicenters*, 601 F.2d at 1015
28 n.11; *Van Well Nursery, Inc. v. Mony Life Ins. Co.*, 421 F. Supp. 2d 1321, 1327-

1 28 (E.D. Wash. 2006) (“Even the most distinctive symbols – coined words
2 having no descriptive or suggestive quality – may become generic if they are
3 adopted by the public as the name of the product rather than as the mark of the
4 producer.”) See also *In re Reckitt & Colman, North America Inc.*, 18
5 U.S.P.Q.2d (BNA) 1389 (TTAB 1991) (PERMA PRESS generic for soil and
6 stain removers for use on permanent press products).

7 16. The test is whether the relevant public would understand the term
8 to be generic. See *In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 92
9 U.S.P.Q.2d (BNA) 1682, 1685 (Fed. Cir. 2009).

10 17. As the Ninth Circuit stated in *Rudolph*:

11 “The question of genericness is often answered by reference to the
12 “who-are-you/what-are-you” test: a valid trademark answers the
13 former question, whereas a generic product name or adjective
14 answers the latter.”

15 *Rudolph*, 482 F.3d at 1198, citing *Filipino Yellow Pages*, 198 F.3d at 1147 (“[I]f
16 the primary significance of the trademark is to describe the *type of product*
17 rather than the *producer*, the trademark is a generic term and cannot be a valid
18 trademark.”) (emphasis in original); *Anti-Monopoly, Inc. v. General Mills Fun*
19 *Group*, 611 F.2d 296, 301 (9th Cir. 1979) (“At its simplest, the [genericness]
20 doctrine states that when a trademark primarily denotes a product, not the
21 product’s producer, the trademark is lost.”).

22 2. **Glidewell’s “BruxZir” Mark Should Be Canceled Because It Is**
23 **Phonetically Equivalent To And A Misspelling Of “Bruxer”**

24 18. Courts have long held that the corrupted spelling or phonetic
25 equivalent of a generic term is also generic. See, e.g., *Soweco, Inc. v. Shell Oil*
26 *Co.*, 617 F.2d 1178, 1186 n.24 (5th Cir. 1980) (citing *Miller Brewing Co. v. G.*
27 *Heileman Brewing Co.*, 561 F.2d 75, 79 (7th Cir. 1977); *Am. Aloe Corp. v. Aloe*
28 *Creme Labs., Inc.*, 420 F.2d 1248, 1253 (7th Cir. 1970); see MCCARTHY ON

1 TRADEMARKS, 4TH EDITION, § 12:38; *Rudolph Int'l v. Realys Inc.*, 482 F.3d
2 1195, 1198 (9th Cir. 2007) (citing to *Nupla Corp. v. IXL Mfg. Co.*, 114 F.3d
3 191, 196 (Fed. Cir. 1997); *Brookfield Communications v. West Coast*
4 *Entertainment*, 174 F.3d 1036, 1058 fn. 19 (9th Cir. 1999) (citing to *Miller*
5 *Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 81 (7th Cir. 1977); *C-*
6 *Thru Ruler Co. v. Needleman*, 190 U.S.P.Q. (BNA) 93 (E.D. Pa. 1976); *In re*
7 *Hubbard Milling Co.*, 6 U.S.P.Q.2d (BNA) 1239 (TTAB 1987).

8 19. If a mark bears a misspelling and is phonetically identical to an
9 otherwise descriptive or generic term, it is considered a “legal equivalent” and
10 will be treated the same as would the ordinary spelling. *In Re State Chemical*
11 *Manufacturing Co.*, 225 U.S.P.Q. (BNA) 687 (TTAB 1985) (FOM held to be
12 legal equivalent of “foam” despite differences in appearance and spelling;
13 referencing prior “legal equivalents” cases, namely, TINTZ for tints, ALKOL
14 for alcohol, LITE for light, SAVON GAS for “save on gas”); see also *In re*
15 *Vanilla Gorilla*, 80 U.S.P.Q. 2d (BNA) 1637, 1640 (TTAB 2006) (“3-O’s”
16 merely descriptive of car wheel rims)

17 20. The “intended user” can also be the basis for refusal of registration
18 on the grounds of genericness. In *In re Mortgage Bankers Association of*
19 *America*, 226 U.S.P.Q. (BNA) 954 (TTAB 1985); *In re Reed Elsevier*
20 *Properties Inc.*, 482 F.3d 1376 (Fed. Cir. 2007).

21 **D. Alternatively, Glidewell’s BRUXZIR Mark Is Merely Descriptive**
22 **And Has Not Acquired Secondary Meaning**

23 **1. Glidewell’s BRUXZIR Mark Merely Describes The Intended**
24 **User And Characteristics of The Product**

25 21. A term that identifies a group to whom the applicant directs its
26 goods or services is merely descriptive. See *In re Planalytics, Inc.*, 70
27 U.S.P.Q.2d (BNA) 1453 (TTAB) 2004); *Hunter Publ’g Co. v. Caulfield Publ’g*
28 *Ltd.*, 1 U.S.P.Q.2d (BNA) 1996 (TTAB 1986); *In re Camel Mfg. Co., Inc.*, 222

1 U.S.P.Q. (BNA) 1031 (TTAB 1984). Trademark Manual of Examining
2 Procedure (TMEP), § 1209.03(i).

3 22. Rather than immediately conveying a brand or product source,
4 merely descriptive marks “immediately convey[] knowledge of a quality,
5 feature, function or characteristic of the goods or services with which [they are]
6 used.” *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963 (Fed. Cir. 2007)
7 (emphasis omitted).

8 23. To be determined merely descriptive and not entitled to
9 registration, it is sufficient to find that the mark “immediately conveys
10 information about one feature or characteristic of at least one of the designated”
11 goods or services within the applicant’s trademark applications. *In re The*
12 *Chamber of Commerce of the United States*, 675 F.3d 1297, 1298-1301 (Fed.
13 Cir. 2012); *Advertise.com*, 616 F.3d at 982; *Japan Telecom, Inc. v. Japan*
14 *Telecom Am., Inc.*, 287 F.3d 866 (9th Cir. 2002).

15 24. Simply combining two descriptive words does not make a mark
16 registrable. *Surgicenters*, 601 F.2d 1011, 9th Cir. (1979), citing *Warner & Co. v.*
17 *Lilly & Co.*, 265 U.S. 526, 528, 44 S.Ct. 615, 68 L.Ed. 1161 (1924).

18 **2. Glidewell Has Failed To Satisfy Its Burden Of Proof of**
19 **Establishing Secondary Meaning**

20 25. “When used to describe a product, [merely descriptive marks] do
21 not inherently identify a particular source, and hence cannot be protected,”
22 unless they have acquired “distinctiveness which will allow them to be protected
23 under the [Lanham] Act.” *Two Pesos, Inc.*, 505 U.S. at 769. “This acquired
24 distinctiveness is generally called secondary meaning.” *Id.* (internal quotation
25 marks omitted).

26 26. “To establish secondary meaning, a manufacturer must show that,
27 in the minds of the public, the primary significance of a product feature or term
28 is to identify the source of the product rather than the product itself.” *Two Pesos*,

1 *Inc.*, 505 U.S. at 766 (citing *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844
2 (1982)).

3 27. The Ninth Circuit has enunciated a four-element test the finder of
4 fact may consider to determine whether a mark has obtained secondary
5 meaning, including: “(1) whether actual purchasers of the product bearing the
6 claimed trademark associated the trademark with the producer, (2) the degree
7 and manner of advertising under the claimed trademark, (3) the length and
8 manner of use of the claimed trademark, and (4) whether use of the claimed
9 trademark has been exclusive.” *Yellow Cab*, 419 F.3d at 930 (citing *Levi Strauss*
10 *& Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1358 (9th Cir. 1985) (en banc)).

11 28. In addition, the Ninth Circuit has considered “direct consumer
12 testimony; survey evidence; exclusivity, manner, and length of use of a mark;
13 amount and manner of advertising; amount of sales and the number of
14 customers; established place in the market; and proof of intentional copying by
15 the defendant.” *Art Attacks Ink, LLC v. MGA Entm’t Inc.*, 581 F.3d 1138 (9th
16 Cir. 2008) (citing *Filipino Yellow Pages, Inc. v. Asian Journal Publ’ns, Inc.*,
17 198 F.3d 1143, 1151 (9th Cir. 1999)).

18 29. Proof of secondary meaning entails rigorous evidentiary
19 requirements. *Express, LLC v. Forever 21, Inc.*, 2010 U.S. Dist. LEXIS 91705
20 (C.D. Cal. 2010); *Seed Lighting Design Co. v. Home Depot*, 2005 U.S. Dist.
21 LEXIS 44741 (N.D. Cal. 2005).

22 30. Because the chief inquiry is the attitude of the consumer “[a]n
23 expert survey of purchasers can provide the most persuasive evidence of
24 secondary meaning. *Sand Hill Advisors, LLC v. Sand Hill Advisors, LLC*, 680 F.
25 Supp. 2d 1107, 1117 (N.D. Cal. 2010) (citing *Vision Sports, Inc. v. Melville*
26 *Corp.*, 888 F.2d 609, 615 (9th Cir. 1989)).

27 31. Courts “generally credit customer surveys as the strongest evidence
28 of secondary meaning.” *Aurora World, Inc. v. TY Inc.*, 719 F. Supp. 2d 1115,

1 1151 (C.D. Cal. 2009) (citing *Levi Strauss*, 778 F.2d at 1358 (en banc)).

2 32. Advertising, standing alone, does not establish secondary meaning.
3 “The ‘true test of secondary meaning’ is the effectiveness of the advertising
4 effort. *Art Attacks*, 581 F.3d at 1146 (citing *Int’l Jensen v. Metrosound U.S.A.*, 4
5 F.3d 819, 824 (9th Cir. 1993)) (affirming summary judgment for alleged
6 infringer).

7 33. “Naturally, a ‘large expenditure of money does not in itself create
8 legally protectable rights.’” *CG Roxanne LLC v. Fiji Water Co. LLC*, 569 F.
9 Supp. 2d 1019, 1031 (N.D. Cal. 2008) (citing *Carter-Wallace, Inc. v. Procter &*
10 *Gamble Co.*, 434 F.2d 794, 800 (9th Cir. 1970).

11 34. Being first to market with a product does not render the product’s
12 name distinctive. *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 119 (1938);
13 *See In re Phoseon Tech. Inc.*, 103 U.S.P.Q.2d (BNA) 1822 (TTAB 2012).

14 35. Secondary meaning must be established through evidence existing
15 at the time the alleged infringer began using the allegedly infringing mark. *Sand*
16 *Hill Advisors*, 680 F. Supp. 2d at 1117 (citing *Levi Strauss & Co. v. Blue Bell,*
17 *Inc.*, 778 F.2d 1352, 1358 (9th Cir. 1985)). “Consequently, only evidence
18 showing use of the mark . . . prior to Defendant’s [allegedly infringing] use of
19 the mark is probative of secondary meaning.” *Id.*

20 36. Length of use and exclusivity are closely tied: without exclusivity
21 it is unlikely that a mark is associated with a single source and without time
22 consumers may not associate a mark with a single source. *Art Attacks*, 581 F.3d
23 at 1146.

24 37. Evidence of product success in the marketplace does not
25 necessarily establish secondary meaning because such success may be easily
26 attributable to the desirability of the product configuration rather than the
27 source-designating capacity of the mark. *Cont’l Lab. Prods. v. Medax Int’l*, 114
28 F. Supp. 2d 992, 1002 (S.D. Cal. 2000) (citing *Duraco Prods., Inc. v. Joy*

1 *Plastic Enters., Ltd.*, 40 F.3d 1431, 1452-53 (3d Cir. 1994). “[S]ales figures
2 alone are inadequate to establish a connection between the product and its
3 source.” *Id.* at 1002 (citing *Seabrook Foods, Inc. v. Bar-well Foods Ltd.*, 568
4 F.2d 1342, 1345 (C.C.P.A. 1977).

5 **E. Cancellation of the BRUXZIR Registration Is In Line With**
6 **Trademark Public Policy**

7 38. In responding to a trademark application, the examining attorney
8 may request that the applicant submit additional explanation or materials to
9 clarify the meaning of the mark or the nature of the goods or services.
10 Trademark Manual of Examining Procedure (TMEP) Section 1209.02; See *In re*
11 *Noble Co.*, 225 U.S.P.Q. (BNA) 749, 750 (TTAB 1985)”)

12 39. When a generic term is enforced as a mark, the public is harmed
13 and the purposes of trademarks are subverted. *Kellogg Co. v. National Biscuits*
14 *Co.*, 305 U.S. 111, 122, 59 S.Ct. 109 (1938) (“Sharing in the goodwill of an
15 article unprotected by patent or trade-mark is the exercise of a right possessed
16 by all – and in the free exercise of which the consuming public is deeply
17 interested.”).

18 40. Granting trademark protection to a generic mark effectively grants
19 the trademark owner a monopoly “since a competitor could not describe his
20 goods as what they are.” *Rudolph*, 482 F.3d 1195, 1199, n.2, quoting
21 *Surgicenters*, 601 F.2d at 1017; *Filipino Yellow Pages, Inc. v. Asian Journal*
22 *Publ’ns, Inc.*, 198 F.3d 1143, 1151 (9th Cir. 1999).

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Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: November 19, 2012 By: /s/ David G. Jankowski
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